

**REMARKS**

Applicants respectfully request reconsideration of the instant application in view of the following remarks. Claims 122-160 are pending in the application. Claims 122, 135, 136, 142, 148, 149, and 155 are independent claims. Applicants have made minor amendments in this response to claims 122, 128, 135, 136, 142 and 155 to address various objections made to these claims. Applicants have further amended each of the independent claims to further clarify the distinctions between the instant invention and cited reference No new claims and no new matter have been added.

**Objections to the Claims**

The Examiner has objected to claims 122, 128, 135, 136, 142 and 155 for various instances of informal language. Applicants have amended these claims to incorporate the Examiner's suggested language to overcome these objections.

**Rejections under 35 USC §103**

The Examiner has rejected each of the pending independent claims under § 103 in view of US Patent Number 5,136,501 to Silverman (the "Silverman patent"), and various instances of Official Notice. Applicants respectfully submit the cited reference fails to disclose or suggest each of the limitations of the pending claims.

Applicants respectfully submit that the instant rejections involve the use of impermissible hindsight to arrive at Applicants' claimed invention. In particular, Applicants

respectfully submit that the instant 103 rejection is centered on the disclosure of a securities trading system to create a new system not contemplated before Applicants' instant application.

Applicants note that the differences between the claimed invention and the cited reference should be readily apparent – in view of the fact that the cited reference is simply not directed to a system designed to facilitate buyer-driven conditional purchase offers. Rather, the cited reference is merely directed to a relatively standard trading system. Applicants' claimed invention is simply not directed to such a standard trading system. Rather, Applicants' claimed invention is directed to a system whereby a conditional purchase offer for goods or services and a payment identifier are received from a customer, and then compared to seller inventory and pricing information of a plurality of sellers of the goods or services to determine if the offer is acceptable. Such a buyer-driven system is simply never contemplated in the cited reference.

With specific reference to the Silverman reference, the Office Action sets-forth that the reference somehow discloses “receiving a payment identifier specifying a financial account for use in providing payment for said goods or service if said conditional purchase offer is accepted”, without providing any support for this proposition in the cited reference (see page 4 of office action). In other areas of the office action, an inference is made that column 7, lines 13-20 of the Silverman reference are directed to the use of a clearing house to effect payment, and therefore certain limitations of Applicants' claimed invention are somehow met. Applicants respectfully submit that the use of a clearing house to effect payment after an offer has been submitted and accepted simply fails to disclose or suggest Applicants' claimed invention. As set-forth in each of the amended independent claims of the instant Application, Applicants' method and system involve receiving a payment identifier specifying a financial account for use in providing payment for the

goods or services if the conditional purchase offer is accepted, prior to any consideration of that offer. Applicants have so amended each of the pending independent claims to further make this distinction clear. No such arrangement is disclosed or suggested in the cited reference.

As such, the claimed invention is clearly patentably distinct from the cited references for at least this reason, among others.

Applicants further note that the independent claims of the instant application are embodied in a tremendously successful commercial enterprise known as priceline.com (the "Company"). Since the filing of the original application, the Company has received millions of conditional purchase offers for a variety of goods and services. Applicants respectfully submit that this evidence of commercial success further highlights the non-obviousness of Applicants' claimed invention.

In view of the fact that each of the independent claims of the instant application are distinguishable from the cited references for the aforementioned reasons, Applicants note that the dependent claims of the instant application are also distinguishable for at least these reasons.

Applicants further note however that the instant office action fails to address the additional limitation set-forth in independent claim 155, in which an acceptance is provided to a customer without an indication of amounts paid to a seller for said goods or services, and payment is provided to a seller for an amount less than and independent of said offer price. Applicants respectfully submit that independent claim 155 and all claims dependent thereon are also allowable for this additional reason.

In view of the aforementioned remarks, Applicants respectfully submit that all of the claims now pending in the application (claims 122-160) are in condition for allowance, which action is earnestly solicited.

If any issues are apparent, or if the Examiner has any suggestions to expedite prosecution, he is invited to contact the undersigned at the telephone number below.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account 13-4500, Order No. 3553-4010US4.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 3553-4010US4. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

### **CONCLUSION**

It is now believed that all pending claims are in condition for allowance. In view of the amendment and remarks, an early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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